

REMARKS

The Office Action of March 6, 2007, has been received and reviewed.

Claims 1-19 are currently pending and under consideration in the above-referenced application, each standing rejected.

Claims 3 and 11-17 have been canceled without prejudice or disclaimer.

Reconsideration of the above-referenced application is respectfully requested.

Drawings

Claims 11-17 have been canceled without prejudice or disclaimer, rendering the objection to the drawings under 37 C.F.R. § 1.83(a) moot.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-19 have been rejected under 35 U.S.C. § 112, second paragraph, for reciting subject matter that is purportedly indefinite.

As claims 3 and 11-17 have been canceled without prejudice or disclaimer, the rejections of these claims are moot.

Independent claim 1 has been amended to include further recitation of the structure and relationship between the body and the grasping element. Furthermore, with respect the recitation that the grasping element includes an end, it is respectfully noted that while the paragraph [0038] of the as-filed application discloses that the grasping element may have a low viscosity and be compressible, paragraph [0038] clearly indicates that these are nonlimiting examples of the possible characteristics of a grasping element, to which independent claim are clearly not limited. Furthermore, the as-filed specification provides examples of grasping element materials that one of ordinary skill in the art would readily understand could be formed into structures that would have an end. *See, e.g.*, paragraph [0036].

Claims 8 and 9 have been revised to clarify the subject matter previously recited therein. It is respectfully submitted that while the revisions to these claims address any issues with respect to indefiniteness, since they merely clarify the previously recited subject matter, the

revisions do not narrow the scope of either claim 8 or claim 9, or of any other claim that is still pending in the above-referenced application.

It is respectfully submitted that each of claims 1, 2, 4-10, and 18 and 19 complies with the definiteness requirement of the second paragraph of 35 U.S.C. § 112. Accordingly, withdrawal of the 35 U.S.C. § 112, second paragraph, rejections of these claims is respectfully solicited.

Rejections under 35 U.S.C. § 102

Each of claims 1-5, 8, 9, and 11-19 has been rejected under 35 U.S.C. § 102.

A claim is anticipated only if each and every element, as set forth in the claim, is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegual Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Den Hamer

Claims 1-5, 8, 9, and 11-19 are rejected under 35 U.S.C. § 102(b) for being drawn to subject matter that is allegedly anticipated by the subject matter described in U.S. Patent 3,797,875 to den Hamer (hereinafter “den Hamer”).

The disclosure of den Hamer relates to a pen-like device for handling small objects. The den Hamer device employs an adhesive element 6 that protrudes from an end of the device. *See, e.g.*, FIG. 1; col. 2, lines 16-19.

den Hamer includes no express or inherent description that the device disclosed therein includes a tip that is secured to a body, and configured to be *rotated* relative to the body to define the position of an end of a grasping element relative to a free end of the tip.

Furthermore, den Hamer lacks any express description that the adhesive element of the device disclosed therein may be used while “leaving substantially no residue.” Instead, den Hamer’s disclosure with respect to suitable adhesive element 6 materials is limited to beeswax and “numerous synthetic rubber adhesives.” Col. 1, lines 56-59. As beeswax and many

synthetic rubber adhesives would leave a residue on a surface contacted thereby, den Hamer does not inherently describe each and every element of independent claim 1. *See*, M.P.E.P. § 2112.

Therefore, it is respectfully submitted that den Hamer does not anticipate each and every element of amended independent claim 1, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 1.

Claims 2, 4, 5, 8, and 9 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Claim 5 is further allowable because den Hamer neither expressly nor inherently describes a device with a tip with threading that is complementary to threading of an outer housing of that device.

Claims 3 and 11-17 have been canceled without prejudice or disclaimer, rendering the rejections of these claims moot.

Independent claim 18, as amended and presented herein, recites a tip for a hand-held pick-and-place apparatus. The tip of amended independent claim 18 includes, among other things, a body engagement element that is configured to be rotated relative to a body of the hand-held pick-and-place apparatus so as to cause a grasping element to be extruded from the tip or retracted therein.

den Hamer includes no express or inherent description of such a tip. Rather, the description of den Hamer is limited to use of a screw 4 and piston 5 to extrude an adhesive element 6 (col. 2, lines 16-19), and a finger key 9 to extend expose and retract the adhesive element 6 (col. 2, lines 20-27).

Therefore, under 35 U.S.C. § 102(b), the subject matter recited in amended independent claim 18 is allowable over the subject matter described in den Hamer.

Claim 19 is allowable, among other reasons, for depending directly from amended independent claim 18, which is allowable.

Mark

Claims 1-5, 8, 9, and 11-19 have been rejected under 35 U.S.C. § 102(b) for being drawn to subject matter that is allegedly anticipated by the subject matter described in U.S. Patent 6,238,120 to Mark (hereinafter “Mark”).

Like den Hamer, Mark does not expressly or inherently describe a hand-held pick and place apparatus that includes den Hamer includes no express or inherent description that the device disclosed therein includes a tip that is secured to a body and configured to be *rotated* relative to the body to define the position of an end of a grasping element relative to a free end of the tip.

Therefore, Mark does not anticipate each and every element of amended independent claim 1, as would be required to maintain the 35 U.S.C. § 102(b) rejection against amended independent claim 1.

Claims 2, 4, 5, 8, and 9 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Claims 3 and 11-17 have been canceled without prejudice or disclaimer, rendering the rejections of these claims moot.

Independent claim 18, as amended and presented herein, recites a tip for a hand-held pick-and-place apparatus. The tip of amended independent claim 18 includes, among other things, a body engagement element that is configured to be rotated relative to a body of the hand-held pick-and-place apparatus so as to cause a grasping element to be extruded from the tip or retracted therein.

Mark includes no express or inherent description of such a tip. Rather, the description of Mark is limited to a syringe-like element with a plunger that moves longitudinally relative to a barrel to extrude liquid. There is no requirement that the plunger of the device described in Mark rotate relative to the barrel to extrude liquid.

Therefore, under 35 U.S.C. § 102(b), the subject matter recited in amended independent claim 18 is allowable over the subject matter described in Mark.

Claim 19 is allowable, among other reasons, for depending directly from amended independent claim 18, which is allowable.

It is respectfully requested that the 35 U.S.C. § 102(b) rejections of claims 1-5, 8, 9, and 11-19 be withdrawn, and that each of claims 1, 2, 4, 5, 8, 9, 18, and 19 be allowed.

Rejections under 35 U.S.C. § 103(a)

Claims 6, 7 and 10 have been rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is purportedly unpatentable over the subject matter taught in den Hamer, in view of teachings from U.S. Patent Application Publication 2003/0099746 of Palmer (hereinafter “Palmer”).

Claims 6, 7, and 10 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Claim 7 is further allowable since neither den Hamer nor Palmer teaches or suggests a cap that is configured to rotate a tip when the cap is secured to the tip.

Mark in View of Otake

Claims 6, 7, and 10 have been rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is purportedly unpatentable over the subject matter taught in Mark, in view of teachings from U.S. Patent 5,388,726 of Otake (hereinafter “Otake”).

Claims 6, 7, and 10 are each allowable, among other reasons, for depending directly or indirectly from independent claim 1, which is allowable.

Claim 7 is further allowable since neither Mark nor Otake teaches or suggests a cap that is configured to rotate a tip when the cap is secured to the tip.

Withdrawal of the 35 U.S.C. § 103(a) rejections of claims 6, 7 and 10 is respectfully solicited, as is the allowance of these claims.

CONCLUSION

It is respectfully submitted that each of claims 1, 2, 4-10, 18, and 19 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brick G. Power", written in a cursive style.

Brick G. Power

Registration No. 38,581

Attorney for Applicants

TRASKBRITT

P.O. Box 2550

Salt Lake City, Utah 84110-2550

Telephone: 801-532-1922

Date: September 6, 2007

BGP/dlm:ec